

35 U.S.C. 103(a) rejection

Claims 1 and 4-11 remain rejected by the examiner as being obvious over Kinzer et al. (U.S. Patent 5,667,893) individually or in view of Wiest et al. (U.S. Patent 4,322,516 – for claims 6 and 11). The applicants' request reconsideration for the following reasons.

The Kinzer et al. reference differs from the applicants invention as claimed in at least two ways which has not been accounted for with the rejection of Kinzer et al. in view of Wiest et al. First, the primary component of the photopolymerizable epoxy composition of the Kinzer et al. reference is a plurality of epoxides (see col. 2, Summary of the Invention) whereas the applicants' crosslinked epoxy resin is comprised of an epoxy component and an amine component.

Neither the Kinzer et al. reference nor the Wiest et al. reference teach or suggest adding an amine component to the epoxy composition of Kinzer et al. Moreover, given the additional components which are required by Kinzer et al.'s epoxy composition (i.e. "at least one organometallic cationic initiator") and the optional ingredients thereof ("optionally, at least one accelerating agent" (i.e. peroxides)), one of ordinary skill in the art would be directed away from adding an amine component as the applicants' have done (see also MPEP 2143.1, page 2100-125, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).").

Second, it is unclear that Kinzer et al. actually teaches a crosslinked epoxy resin. Kinzer et al. at best teaches that their epoxy compositions are "photopolymerized". However, there is no indication that this is equivalent to being crosslinked. In addition, Kinzer et al. also appears to teach away from their epoxy composition being crosslinked as it is described in their Summary of the Invention that "...the present invention provides an article comprising a substrate coated with a flexible epoxy composition."

If the examiner is relying on inherency to establish that Kinzer et al. teaches a crosslinked epoxy resin, MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "*The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by

persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

It is also insufficient to do no more than broadly allege that claim limitations are disclosed in the prior art "either expressly or inherently" as the Federal Circuit noted in *Electro Scientific Industries, Inc. v. General Scanning, Inc.*, 247 F.3d 1341, 58 USPQ2d 1498 (Fed. Cir. 2001).

For either of the above reasons, it is believed that the applicants' claims are unobvious in light of Kinzer et al. alone or in view of Wiest et al.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (4 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 26 March 2003

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